

Second, the Examiner's proposed approach is explicitly disapproved of at M.P.E.P. §704.01, which reads in relevant part:

PREVIOUS EXAMINER'S SEARCH

When an examiner is assigned to act on an application which has received one or more actions by some other examiner, full faith and credit should be given to the search and action of the previous examiner unless there is a clear error in the previous action or knowledge of other prior art. In general the second examiner should not take an entirely new approach to the application or attempt to reorient the point of view of the previous examiner, or make a new search in the mere hope of finding something.

The previous Examiner issued two substantive Office Actions in which the claims were thoroughly examined in view of the prior art and 35 U.S.C. §112, resulting in most the claims being allowed. M.P.E.P. §704.01 states that the current Examiner should give "full faith and credit" to the previous Examiner's work rather than "tak[ing] an entirely new approach to the application," which seems to be what the current Examiner is proposing.

Third, such a piecemeal approach is particularly inappropriate in this application. More than two years elapsed between the Applicant's last response and the current Office Action (containing only a restriction requirement). This long delay was the result of the application being lost by U.S. Patent and Trademark Office. It is extremely unfair that now, after such a long delay that was not the Applicant's fault, after the application had been given a thorough examination and most claims allowed, the Applicant should find himself back at square one.

Despite being unhappy with her proposed course of action, the Applicant sincerely thanks the current Examiner for her apology on behalf of the U.S. Patent and Trademark Office for the lengthy interval of time that elapsed between the Applicant's response on February 28, 2001 and the current Office Action, an interval in which the application was misplaced by the U.S. Patent and Trademark Office. The interval that elapsed was in no way the current Examiner's fault and the Applicant thanks the current Examiner for her diligent efforts to locate the application.

The Applicant notes that in the Office Action dated November 30, 2000, the previous Examiner returned a copy of the Form 1449 that had been submitted with the Information Disclosure Statement filed September 12, 2000. The previous Examiner placed his initials next to each entry on the Form 1449 except one: Upcroft P., et al. Rapid and efficient method for cloning of blunt-ended DNA fragments. Gene. 1987;51(1):69-75. No explanation for this omission was given in the Office Action. The Applicant requests that the current Examiner consider Upcroft P., et al. Rapid and efficient method for cloning of blunt-ended DNA fragments. Gene. 1987;51(1):69-75. For the convenience of the current Examiner, the Applicant has enclosed a copy of Upcroft P., et al. Rapid and efficient method for cloning of blunt-ended DNA fragments. Gene. 1987;51(1):69-75 and a copy of the Form 1449. The Applicant requests that the current Examiner return a copy of the Form 1449 with her initials next to the entry for Upcroft P., et al. Rapid and efficient method for cloning of blunt-ended DNA fragments. Gene. 1987;51(1):69-75 after the current Examiner has considered this publication.

THE RESTRICTION REQUIREMENT

The Examiner required restriction to one of the following groups:

Group I – Claims 1-30, drawn to methods of inserting a nucleic acid fragment into a circular vector;

Group II – Claims 33-36 and 65, drawn to a mixture of nucleic acid vectors;

Group III – Claims 37-38, 40-41, 54-55, 60-61, and 66, drawn to nucleic acid inserts, kits, vectors and libraries wherein the nucleic acids comprise cohesive ends which cannot be covalently joined by ligase;

Group IV – Claims 42-47, 51-52, and 57-58, drawn to nucleic acid inserts, kits, vectors and libraries wherein the nucleic acids comprise an end linked to a topoisomerase;

Group V – Claims 48-50, drawn to a nucleic acid insert and kit comprising a cos site;

Group VI – Claims 53, 56, 59, and 62, drawn to a nucleic acid insert, construct, and libraries, wherein the insert does not comprise a cos site;

Group VII – Claims 63-64, drawn to libraries of nucleic acid vectors without an insert size bias; and

Group VIII – Claims 67-68, drawn to methods for insertion of a nucleic acid into a circular vector.

The Applicants elect, without traverse, Group I, claims 1-30.

The time for responding to the Office Action was set for April 13, 2003. Enclosed herewith is a Petition for the Extension of Time under 37 C.F.R. § 1.136(a) for a period sufficient to permit the filing of this response.

The Applicants hereby also make a Conditional Petition for any relief available to correct any defect seen in connection with this filing, or any defect seen to be remaining in this application after this filing. The Commissioner is authorized to charge Kenyon & Kenyon's Deposit Account No. 11-0600 for the Petition fee and any other fees required to effect this Conditional Petition.

Respectfully submitted,

Date: May 13, 2003



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**INFORMATION DISCLOSURE
STATEMENT BY APPLICANTS**

ATTY. DOCKET NO.
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SERIAL NO.
09/213,834

APPLICANT(S)
Y. Romantchikov

FILING DATE
December 17, 1998

GROUP
1631

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U. S. PATENT DOCUMENTS

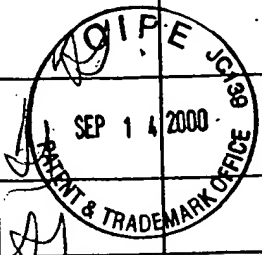










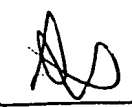
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FOREIGN PATENT DOCUMENTS

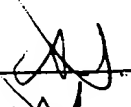
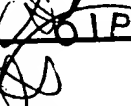

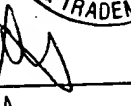
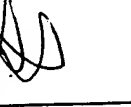
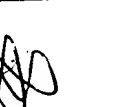
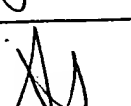

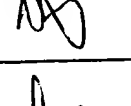
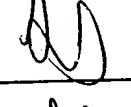
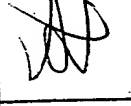


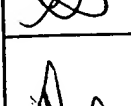
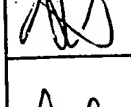
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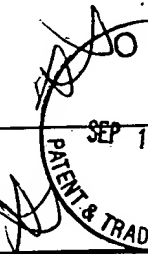
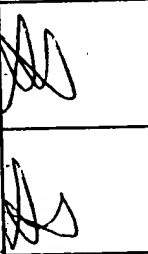
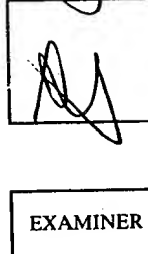



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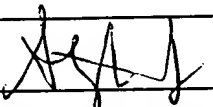
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EXAMINER: Initial if citation considered, whether or not citation is in conformance with M.P.E.P. 609; draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.	